

### **REMARKS**

The present amendment is in response to the Office action dated 31 July 2008, where the Examiner has maintained the rejection of claims. In the present amendment, claims 17, 29 and 32 have been amended and claim 30 has been canceled. Accordingly, claims 17-29 and 31-37 are pending in the present application with claims 17, 29, and 32 being the independent claims. Reconsideration and allowance of pending claims 17-29 and 31-37 in view of the amendments and the following remarks are respectfully requested.

#### **A. 35 USC §112**

Claims 32-37 stand rejected under section 112 ¶1 as failing to comply with the written description requirement. Specifically, the Examiner identified elements 2, 3 and 5 of claim 32 as including new subject matter. Below is a table demonstrating support for these elements in at least paragraphs 109-110.

Claim element	Specification support
removing said first content from said first document;	¶110 discusses editing content, including the ability to delete content
generating a second document, wherein the second document includes said first content;	¶110 discusses creating documents with content; ¶107 and Figs. 4(b) and 4(d) discuss and illustrate content from one document included in a second document.
determining a second URL corresponding to the second document;	¶109 discusses determining a second URL that is different

The Office Action states that the claims contain subject matter that was not described in the specification because the Examiner was unable to find support for the added limitations even though Applicant identified certain paragraphs in the specification that support the claim language. The Examiner appears to be requiring

literal support for the claim language, which is a misapplication of the governing statute.

35 U.S.C. §112 states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

There is no requirement in section 112 for literal support of the claim language. *In re Oda*, 443 F.2d 1200 (CCPA 1971); MPEP §2163(I)(B). Accordingly, the use of terms in a claim that do not appear in the specification is not, per se, new subject matter. The standard set forth in section 112 is instead that one skilled in the art would recognize that Applicant was in possession of the claimed invention and that one skilled in the art be able to make and use the claimed invention in order to put the public in possession of the claimed invention. *In re Barker*, 559 F.2d 588, 592 n.4 (CCPA 1977); *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566 (Fed. Cir. 1997).

Here, claim 32 requires removing said first content from said first document and at least paragraph 110 of the specification discloses the ability to delete content. Additionally, claim 32 requires generating a second document, wherein the second document includes said first content and at least paragraph 110 discusses creating documents with content and at least paragraph 107 discusses generating a second document that includes content from a first document. Also see the comparison of Fig. 4(a) and Fig. 4(d). Finally, claim 32 requires determining a second URL corresponding to the second document and at least paragraph 109 discusses determining a URL for a document. Accordingly, the specification conveys with reasonable clarity to one skilled in the art that Applicant was in possession of the claimed invention at least as early as the filing date of the present application. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). Accordingly, Applicant believes that the statutory burden under 35 USC § 112 has been met and requests that the rejection be withdrawn.

***B. Examiner's Response to Arguments***

Applicant thanks the Examiner for the explanation provided in the Response to Arguments section of the Office Action. With respect to the 103 arguments presented by Applicant, the Examiner states that the claims do not recite the feature that is missing from the references, namely that "*the location of the source document changes.*" The Examiner also notes that the claims fail to mention a "*source document*" or "*changing the location of a source document.*" However, claim 17 clearly requires generating a document, publishing the document to a current location and then publishing the document to a new location after modifying the document based on a new relative URL. Applicant's arguments that describe that document as a "source" document are not confusing and the Examiner's assertion that the features upon which Applicant relies are not recited in the claims demonstrates a failure to comprehend the claimed invention.

Applicant's arguments are clear and Applicant's claims are clear. The failure of the cited references to disclose the required elements of claim 17 is also clear. Applicant asserts that claim 17 and its respective dependent claims are presently in condition for allowance and respectfully requests an indication that the claims are allowable.

In paragraph 28 of the Response to Arguments section, the Examiner states that the balance of Applicant's arguments are directed toward the "*source document*" and "*target document*" aspects of the invention. This statement reveals a misunderstanding of the claimed invention and the prior art. Applicant has used this terminology in its arguments to clarify the differences between the cited references and the claimed invention. The cited references are directed toward updating URLs when the target document moves. The target document is the document to which the URL in the source document points. If the Examiner does not understand this, Applicant requests that an interview be scheduled to clarify. However, Applicant believes that the Examiner does understand this and therefore Applicant respectfully requests that the claims be

indicated as allowable in the next action because the cited references clearly fail to disclose updating URLs when the location of the source document changes.

***C. Amendment to Preamble of Independent Method Claims***

In accordance with the recently published interim patent subject matter eligibility examination instructions, Applicant has amended the preamble of the independent method claims to clarify that the claims are computer implemented inventions where one or more computers are programmed to perform the steps to implement the method. These claims were already directed toward computer implemented methods and the present amendments to the preambles are for clarification purposes with respect to section II(B) of the interim instructions.

***D. 35 USC §103(a), Claims 17-31***

In the Office Action, claims 17-37 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,684,369 (“Bernardo”) in view of U.S. Patent No. 6,606,653 (“Ackerman”) and further in view of U.S. Patent No. 6,578,078 (“Smith”). As set forth in MPEP § 2143, in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S. Ct. 1727, 82 USPQ2d 1385, 1395-97 (2007) the Supreme Court identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The KSR Court noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.

Applicant incorporates its remarks from prior papers regarding the present condition for allowance of claim 17 and its respective dependent claims.

With respect to independent claim 29, this claim has been amended to more clearly define what applicant regards as the invention. Specifically, claim 29 has been amended to clarify that a first document containing a relative URL is published to a first

location. The relative URL corresponds to the first location. A second location is identified for the first document and the relative URL is modified so that it corresponds to the second location. The modified first document is then published to the second location.

As previously explained with respect to claim 17, none of the cited references disclose modifying a URL in a document when the location of that document changes. Claim 29 requires that a relative URL that corresponds to a first location of the document be modified so that the relative URL corresponds to a second location of the document and that the modified document (the document with the modified relative URL) be published to the second location.

The combination of Bernardo, Ackerman, and Smith fails to disclose the required steps of claim 29. Applicant therefore respectfully requests that claim 29 be indicated as allowable.

***D. 35 USC §103(a), Claims 32-37***

Applicant incorporates its remarks from prior papers regarding the present condition for allowance of claim 32 and its respective dependent claims.

Applicant has amended independent claim 32 for clarity. Specifically, Applicant has clarified that the second URL that is determined corresponds to the first content in the second document. Accordingly, claim 32 requires that a first document be generated and that the first document has a same page link URL that references first content in the first document. A second document is generated that includes the first content. A second URL is determined that references the first content in the second document. The same page link URL in the first document is then replaced with the second URL.

The combination of Bernardo, Ackerman and Smith do not disclose these steps and the rejection of claim 32 outlined in paragraph 21 fails to make a prima facie case of obviousness. The rejection fails to explicitly identify the steps of the claimed method and where those steps are disclosed in the cited references. Instead, the office action

merely summarizes the disclosure from the references. Nowhere do the cited references disclose generating a second document that includes content from a first document. Nowhere do the cited references disclose determining a second URL corresponding to the first content in the second document. Nowhere do the cited references disclose replacing the URL in the first document that pointed to the first content with the second URL that points to the first content in the second document. The office action does not cite any reference as disclosing these steps in claim 32. Accordingly, Applicant asserts that claim 32 is presently in condition for allowance.

Furthermore, the cited references do not disclose replacing a same page URL with a variety of different types of relative links, as required by dependent claims 33 – 37. Accordingly, Applicant believes that independent claim 32 and each of its dependent claims 33 – 37 are presently in condition for allowance and an indication that these claims are allowable is respectfully requested.

**CONCLUSION**

For all the foregoing reasons, allowance of pending claims 17-29 and 31-37 is respectfully requested. If the Examiner believes that a telephone conversation may be useful in advancing prosecution, the Examiner is invited to contact the undersigned at the number listed below. If necessary, applicant requests to extend the period for filing this reply pursuant to 37 CFR 1.136(a) and authorizes the Director to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Procopio Deposit Account No. 50-2075.

Respectfully submitted,

Dated: September 25, 2009

By: /Patric J. Rawlins/  
Patric J. Rawlins  
Reg. No. 47,887

Procopio, Cory, Hargreaves & Savitch LLP  
530 B Street, Suite 2100  
San Diego, California 92101-4469  
(619) 238-1900